

REMARKS

In the Office Action dated January 13, 2005, claims 13-25, 28, and 29 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 8-10, and 16-25 of U.S. Patent no. 6,763,889; claims 13, 14, 28, and 29 were rejected under 35 U.S.C. § 102 over U.S. Patent Application Publication No. 2002/0134552 (Moss); claims 1-3, 5, 6, 9, 10, 15-18, 20-23, and 25 were rejected under § 103 over Moss; claims 4, 7, 19, and 26 were rejected under § 103 over Moss in view of U.S. Patent No. 6,209,634 (Avakov); claims 8 and 30-32 were rejected under § 103 over Moss in view of U.S. Patent No. 5,657,823 (Kogure); claim 27 was rejected under § 103 over Moss in view of Avakov and Kogure; claims 11 and 12 were rejected under § 103 over Moss in view of U.S. Patent No. 5,676,209 (Reynolds).

Applicant acknowledges the indication that claim 24 would be allowable if rewritten in independent form.

A terminal disclaimer is submitted herewith to overcome the obviousness-type double patenting rejection.

Independent claims 13, and 28 have been cancelled, without prejudice, to render the rejection of the claims moot.

Claim 15 has been amended from dependent form to independent form with the scope of claim 15 remaining *unchanged*. Claim 15 was rejected as being obvious over Moss alone. The Office Action conceded that Moss does not disclose an underwater marine unit that comprises an interface to receive wireless signals. 1/13/2005 Office Action at 3. However, the Office Action took Official Notice that such a feature was well known. Applicant respectfully traverses the taking of this Official Notice. As stated by the M.P.E.P., “[o]fficial notice unsupported by documentary evidence should only be taken by the examiner when the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.” M.P.E.P. § 2144.03 (8th ed., Rev. 2), at 2100-136. There is no evidence that an underwater marine unit that has an interface to receive wireless signals and that is adapted to operatively couple a carrier line on a carrier line spool to subsea wellhead equipment is of “instant and unquestionable demonstration as being well-known.” “It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference

where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” *Id.* Also, as stated by the M.P.E.P., “[i]t is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.” *Id.* at 2100-137.

Applicant respectfully requests the production of a documentary evidence to establish that a prior art reference would suggest a modification of the Moss system to use an underwater marine unit having an interface to receive wireless signals for coupling a carrier line of a carrier line spool to subsea wellhead equipment. Absent such a reference, it is respectfully submitted that there is no evidence to support the assertion in the Office Action that the features of claim 15 would be obvious. To establish a *prima facie* case of obviousness, the Office Action must provide evidence supporting a motivation or suggestion to modify the teachings of Moss to achieve the claimed invention. The Office Action has failed to do so, and therefore, a *prima facie* case of obviousness has not been established with respect to claim 15.

Claim 29 has been amended from dependent form to independent form. Claim 29 is also similarly allowable over Moss.

Independent claim 1 was rejected as being obvious over Moss alone. The Office Action conceded that Moss fails to disclose a stack separate from a carrier line spool. 1/13/2005 Office Action at 4. However, the Office Action stated that the subject matter of claim 1 would be obvious because separating sections of the stack carrying the spool and the injector “involves only routine skill in the art.” *Id.* at 4. Applicant respectfully submits that a *prima facie* case of obviousness has not been established with respect to claim 1. There is no evidence to support the assertion made in the Office Action that there existed a motivation or suggestion to modify Moss to achieve the claimed invention, in which a stack is in a structure separate from a carrier line spool. In fact, Moss specifically teaches away from separating the carrier line spool from the rest of the stack, since Moss teaches that all of the elements of Fig. 2 (the intervention system) are “packaged in a three-dimensional space frame 29.” Moss, ¶ [0018]. “The intervention system is simply enclosed inside a space framed to provide structural support for the components as they are transported, deployed, retrieved, or repaired.” Moss, ¶ [0019]. In other words, Moss teaches the importance of integrating or packaging the offset reel 22 along with the rest of the intervention system, as depicted in Fig. 2 of Moss. A person looking to the teachings of Moss

would have been taught to use a packaged frame to enclose all the elements of the intervention system. This teaching is inconsistent with the subject matter of claim 1, which recites a stack separate from the carrier line spool. In view of the foregoing, because no motivation or suggestion existed to modify the teachings of Moss to achieve the claimed invention, a *prima facie* case of obviousness has not been established with respect to claim 1.

Similarly, a *prima facie* case of obviousness has also not been established with respect to independent claim 17, which recites attaching a stack to subsea wellhead equipment, where the stack is in a structure separately located from the carrier line spool.

Claim 4, which depends from claim 1, was rejected as being obvious over Moss and Avakov. The Office Action conceded that Moss fails to disclose a carrier line spool placed on the sea floor separate from the stack. However, the Office Action relied upon Avakov as teaching this feature. Avakov does *not* teach the positioning of its drum/reel on a sea floor. In fact, Avakov teaches that the drum/reel is *positioned on a truck for mobile operations*. Avakov, 5:53-55. Placing the drum/reel of Avakov on a sea floor would directly contradict the teaching of Avakov that the drum/reel should be supported on a truck for mobile operations.

Moreover, Fig. 1 of Avakov is a schematic diagram not intended to be to scale. There is no teaching whatsoever that the drum/reel 20 of Avakov can be positioned underwater, let alone on the sea floor. The assertion made in the Office Action is not based on any specific teaching of Avakov. Therefore, it is respectfully submitted that even if Avakov can be combined with Moss, the hypothetical combination of Moss and Avakov does not teach or suggest all elements of the claim. Moreover, as Avakov teaches away from the invention, namely that the drum/reel must be supported on a truck for mobile operations, rather than on a sea floor, it is also respectfully submitted that no motivation or suggestion existed to combine the teachings of Moss and Avakov to achieve the claimed invention. For the foregoing reasons, it is respectfully submitted that a *prima facie* case of obviousness has not been established with respect to Moss and Avakov.

Similarly, with respect to claim 26 (which depends from claim 17), a *prima facie* case of obviousness has not been established over Moss and Avakov, as the asserted combination of references does not teach or suggest lowering, using an underwater marine unit, the carrier line spool to a position on a *sea floor*.

Independent claim 30 was rejected as being obvious over Moss and Kogure. The Office Action conceded that Moss fails to disclose attaching one or more buoyancy tanks to at least one of the modules containing intervention equipment. 1/13/2005 Office Action at 5. However, reliance was made on Kogure as teaching the missing feature.

As stated in Moss, a goal of its proposed invention is the elimination of a riser to the surface. Moss, ¶¶ [0012]-[0013]. Kogure is directed to a riser that includes a riser stabilizing system and supplementary buoyancy tanks fixedly positioned to the upper end of the riser 16. Kogure, 3:14-18; 3:25-26, 4:31-33. Thus, while Moss teaches the elimination of a riser, Kogure teaches the exact opposite -- a specific type of riser with equipment to support ease of use of the riser. Combining the teachings of Moss and Kogure would defeat the goals and objective of both references. A basic requirement of establishing a *prima facie* case of obviousness is that a proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference. *Id.*, § 2145, at 2100-156. Therefore, there can be no motivation or suggestion to combine the teachings of Kogure and Moss.

The Office Action stated that the teachings of Kogure regarding a riser and riser stabilization system, and the teachings of Moss directed to elimination of a riser from an underwater installation, does not prevent the combination of Moss and Kogure since the Office Action is not “using the primary function of the Kogure et al. patent in combination with Moss.” 1/13/2005 Office Action at 6. Ignoring significant parts of the teachings of Kogure and Moss to provide the obviousness rejection based on Moss and Kogure is error. As stated by the M.P.E.P., a prior art reference “must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” M.P.E.P. § 2141.03, at 2100-127. Therefore, it is respectfully submitted that due to the nature of the teachings of Moss and Kogure, a person of ordinary skill in the art would not have been motivated to combine their teachings. A *prima facie* case of obviousness of claim 30 over Kogure and Moss has therefore not been established.

All dependent claims, including newly added dependent claims 33 and 34, are allowable for at least the same reasons as corresponding independent claims. Note that claim 33 recites subject matter similar to the subject matter of claim 24, indicated by the Office Action as containing allowable subject matter.

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In view of the foregoing, allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 20-1504 (SHL.0099C1US).

Respectfully submitted,

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